REMARKS

The Final Office Action mailed January 27, 2009, has been carefully considered together with each of the references cited therein. The remarks presented herein are believed to be fully responsive to the Office Action. Accordingly, reconsideration of the present Application in view of the following remarks is respectfully requested.

Claim Rejections Under 35 USC § 103(a)

Claims 1-6 and 8-11 stand rejected under 35 USC § 103(a) as being unpatentable over Hartman et al. (US 6,019,833). This rejection is respectfully traversed.

Respectfully stated, it is Applicants' position that the Office has misconstrued the teachings of Hartman et al. and, together with impermissible hindsight has come to the unsustainable conclusion that the instantly claimed invention is therefore obvious.

Hartman et al. disclose a composition that comprises a total of 20 to 70 weight % of white and/or light colored pigment (Column 1, lines 52 through 54) and 0.05 to 5 weight % of a fiberous carbonaceous material, i.e. black, (Column 1, lines 50 through 52). This composition is used as a conductive primer on non-conductive plastic substrates, and afterwards an additional finishing or topcoat is applied onto this cured primer coating (Column 5, lines 10 through 20). In the examples of Hartman et al., the following constituents are used:

Ex.D uses 39.5 % TiO2
Ex.E uses 31.3 % Barium sulfate
Ex.1 has 76.8% of D and 23.1 % of E, i.e. a total of (30.3+7.2) = 37.5 % "light coloured pigment" i.e. WHITE

In substantiating its § 103 rejection, the Office states in Paragraph 5, "[o]ther coloring pigments can be used, such as phthalocyanine blue or phthalocyanine green or metallic effect pigments, such as metal oxide encapsulated micas." Hartman et al. disclose a white (or light coloured) composition used as electrically conductive primer. The coloring pigments, as referenced above are not mentioned in conjunction with, nor are they part of, this primer composition. The coloring pigments are disclosed in Column 5, Lines 11 to 20 and are part of a separate and distinct finishing coat:

> After the primer has been applied to the plastic substrate and cured (i.e. without colored pigments), a finishing or topcoat may be applied directly to the primer coat (i.e. on top of the primer). While the finishing coat may advantageously be the coating composition of the present invention, it can also be any of the compositions known in the art for automotive applications or which is otherwise known for coating plastics. These compositions (i.e. these other known compositions) comprise a resinous binder and a pigment. (Parenthetical comments added)

Hartman goes on to state in Column 5, lines 21 through 30, that these possible pigments <u>in the finishing coat</u> include the phthalocyanine and the mica. Thus, it is unequivocally clear that Hartman et al. does intend the mica or a micaceous material to be in the primer coat, but rather in the finishing coat.

The Office further asserts in Paragraph 6, that "one of ordinary skill in the art would have motivation to use less light colored pigment to change the aesthetic appearance of the final product (i.e. whiter with less color saturation)". This assumption is a clear contradiction of the teachings of Hartman et al. In Column 1 lines 15 - 30, the problem to which the Hartman et al. invention is intended to solve is stated as follows:

> One problem with the use of such parts, however, is that they are more difficult than metal to electrostatically spray paint. This difficulty is at least in part attributable to the fact that static electricity which develops as a result of the use of electrostatic spraying equipment can not be easily dissipated through the nonconductive parts. In order to solve this problem and impart conductivity to such parts it has been the practice to initially paint

> the parts with a primer which is rendered conductive by means of relatively large amounts of conductive carbon black in its composition. Such primers, however, have a resultant disadvantage in that they tend to be black or very dark gray in color. It may, therefore, be difficult to obtain good finishing coat hiding of the primer color.

Given the problem that Hartman et al. intends to overcome, the objective of was to provide a conductive primer, which comprises carbonaceous material, i.e. black material, in an amount of 0.05 to 5.00 %, AND the white and/or light coloured pigment in an amount of 20 to 70 %. The relatively high amount of white and/or light colored pigment is required to ensure, that the primer still is light coloured, i.e. so the black carbonaceous material is not visible.

Consequently, the ordinarily skilled artisan, with a knowledge of Hartman et al. would definitely not have any motivation to reduce the amount of white and/or light colored pigment down to 0.05 to 3%, which is what is explicitly claimed. Because Hartman wants the primer to be white or light colored reducing the white pigment would destroy the white or "light colored" appearance, which is what is desired by the Hartman et al. composition.

In actuality, one with ordinary skill in the art, having a knowledge of Hartman et al. would have an express disincentive to reduce the light colored pigment down to 0.05 to 3%. Furthermore, in order to do so, one would have to necessarily abandon the express teachings of Hartman et al. in order to arrive at the alteration proffered by the Office. Respectfully stated, any motivation to reduce the light colored pigment down to 0.05 to 3%, as is claimed, can only come from the use of impermissible hindsight gained from a knowledge of Applicants' invention.

In summation, an ordinary artisan having an understanding of Hartman et al. would need to make the following modifications in order to render the instantly claimed invention obvious. Not one of these modifications is taught, suggested, implied, or disclosed by Hartman et al., but in contrast, stated courteously, comes

from a reconstruction of the present invention based upon the use of impermissible hindsight:

1) Add mica / micaceous material. Such addition is not disclosed and not suggested in Hartman. The primer of Hartman et al. does not contain mica.

2) Select zinc sulphide out of the rather exhaustive list in Column 2, lines 28 – 35. Stated simply, there is no motivation from Hartman et al. and it is not an obvious selection, since zinc sulphide is mentioned only "inter alia," and no specific examples are disclosed with zinc sulphide.

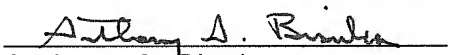
3) Reduce the amount of zinc sulphide far below the explicitly recited recommended minimum advanced by Hartman et al. Moreover, such a modification would invariably contravene the teachings of Hartman because the white pigments MUST be present in such a substantial amount in order to hide the black color of the carboneacous material needed for the invention of Hartman et al.

4) One with ordinary skill in the art could not use the carbonaceous material in the present invention, which is mandatorily required in Hartman et al. to produce the conductivity, because the composition of the instant invention should be laser markable, meaning that when irradiated with a laser, the irradiated spot, i.e. the zinc sulphide, turns from white to dark. Please see page 2 lines 19 to 22 or lines 26 to 29 of the instant Specification. The presence of black would be detrimental for the detection of the laser-induced change. There is absolutely no motivation in Hartman to move the carbonaceous material, since it is required for conductivity purposes.

For at least the foregoing reasons, it is respectfully believed that the instantly claimed invention can not be made obvious by Hartman et al. In consequence, Applicants courteously solicit reconsideration and withdrawal of the rejection.

In view of the forgoing remarks, the present Application is believed to be in condition for allowance, and reconsideration of it is requested. If the Examiner disagrees, he is requested to contact the attorney for Applicants at the telephone number provided below.

Respectfully submitted,



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